

## **REMARKS/DISCUSSION:**

This Response D is being filed within one month after the period for response that ended on October 24, 2010 (the two-month deadline to file an appeal brief based on the Notice of Appeal filed on August 24, 2010). Accordingly, a Petition for a One-Month Extension of Time is made a part of the electronic filing hereof. In lieu of an appeal brief, Applicants are presenting this Response D along with a Request for Continued Examination, filed electronically herewith.

By this Response D, claims 1-8, 10-14 and 16-21 are pending in this application. Claims 1, 6 and 16 have been amended. Claim 9 has been canceled and claim 21 is new. Support for the amendments to claims 1 and 16 can be found at least at ¶ [0006] and Figs. 5-8.

Amendment and/or cancellation of claims are not to be construed as a dedication to the public of any of the subject matter of the claims previously presented. Further, any amendments or arguments are made without conceding the correctness of any of the rejections of the pending Office Action, and Applicant(s) reserves the right to prosecute the subject matter of such claims in continuation and/or divisional applications.

Applicant has carefully studied the outstanding Office Action. This Amendment is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

### **A. Rejection under 35 U.S.C. § 103(a)**

Claims 1-11 and 16-20 stand rejected as being unpatentable over U.S. Patent No. 5,275,607 to Lo in view of Schwemberger, U.S. Patent No. 6,589,200 as noted in the Office Action.

To establish a *prima facie* case for obviousness, the Office must properly ascertain the differences between the prior art and the claimed invention. MPEP § 2141; *Graham v. John Deere Co.*, 383 U.S. 1 (1966). In ascertaining those differences, the Office must make "a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art." *In re Wada and Murphy*, Appeal 2007-3733, slip op.

at p. 7 (BPAI, January 14, 2008) (quoting *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995)) (emphasis in original). The Office must then support a conclusion of obviousness by providing specific reasoning explaining "why every limitation in [the rejected claim] would have been obvious to a person of ordinary skill in the art." *Id.* at pp. 7-8 (emphasis added).

*1. Lo does not disclose a lumen in an overlapping relationship with an asymmetric portion of an ultrasonically actuated blade*

Independent claims 1 and 16 have been amended to recite: a lumen positioned within the outer tubing and having an end positioned in an overlapping relationship with at least a portion of the asymmetric portion of the blade. Lo fails to disclose such a feature as now recited in claims 1, 16 and new claim 21.

Claims 2-9 and 10-11 all depend from claim 1 and claims 17-20 depend from claim 16. Without acquiescing in any way to arguments presented by the Examiner as to these claims, Applicant(s) submits that these claims are likewise patentable over Lo for at least the same reasons as discussed above with respect to claim 1 and 16, respectively, by virtue of their dependency from claims 1 and 16. Withdrawal of the rejections as to these claims is likewise requested.

Applicants further note that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and non-obviousness. For example, and not by limitation, claims 6-8 recite placement of the lumen adjacent a node. Lo neither discloses nor suggests a node or placement of the lumen adjacent a node.

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### **Conclusion**

Applicant submits that in view of the discussion, the rejections under 35 U.S.C. § 103(a) have been overcome and that the invention is now patentable over the cited prior. The Examiner is respectfully requested to reconsider all rejections and pass this case to issue.

Should any minor points remain prior to issuance of a Notice of Allowance, the Examiner is requested to telephone the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, which may be required to Account No. 10-0750/END0797USNP/VEK.

Respectfully submitted,

/Verne E. Kreger, Jr., Reg. No. 35231/Verne E. Kreger, Jr.

Verne E. Kreger, Jr.  
Attorney for the Applicant(s)  
Reg. No. 35,231

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003  
513 337-3295  
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